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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,140	02/09/2004	Davide Dall'osso	2545-0438	5442
7590	10/23/2006		EXAMINER	
TIMOTHY J. KLIMA HARBIN KING & KLIMA 500 NINTH STREET SE WASHINGTON, DC 20003				EDEL, JOHN B
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/773,140	DALL'OSO ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	John B. Edel	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 2-9-2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 7-24 is/are rejected.
- 7) Claim(s) 4-6 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                            | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

(1)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because it cannot be determined which limitations of the separation device are being incorporated by the language "A separation device as in preceding claims."

### ***Claim Rejections - 35 USC § 103***

(2)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 7-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 4,852,588 to Piana et al. ("Piana") in view of United States Patent No. 2,875,689 to D. H. Wright ("Wright").

Regarding Claim 1: Piana discloses a device for separating at least one continuous rod of forming material for the manufacture of tobacco products, applicable in particular to a machine for making tobacco products:

affording a feed path along which the continuous rod is caused to advance (rod B travels in travel direction F in figure 1), and  
equipped with at least one cut-off device by which the continuous rod is severed and diverted from the feed path (deflecting and breaking device 1 in figure 1),

Piana fails to disclose the function of the separation device as being to engage the diverted continuous rod of forming material through the agency of a gripping unit designed to act on the diverted continuous rod by applying forces oriented substantially parallel to a longitudinal dimension of the rod and from opposing directions, so as to

generate a tensile stress in the diverted rod that causes it to break by tearing apart and thus divide into a plurality of discrete lengths.

Wright discloses a paper separation component wherein the separation device engages the work piece through the agency of a gripping unit designed to act on the work piece by applying forces oriented substantially parallel to a longitudinal dimension of work piece from opposing directions, so as to generate a tensile stress in the work piece which causes it to break by tearing apart and thus divide into a plurality of discrete lengths (col. 1 lines 19-25 and col. 3 lines 26-29 and 51-55). Piana and Wright are analogous because they both come from the art of dividing long sections of continuous paper. It would be obvious to combine the paper severing method of Wright with the deflecting and breaking device of Piana because doing so would reduce the amount of crushing, cutting, and or damaging of the tobacco as the continuous rod is broken up<sup>1</sup>.

Regarding Claim 2: Wright further describes a tensioning unit and a braking unit performing the same tearing effect as described in claim 2 (col. 1 lines 19-25 and col. 3 lines 26-29 and 51-55).

Regarding Claim 3: Wright further describes tensioning rollers at the same speed in tangential interaction with the work piece (col. 4 lines 41-65; col. 1 lines 19-25 and col. 3 lines 26-29 and 51-55).

Regarding Claim 7: Wright further discloses that the braking unit comprises rollers working tangentially on opposites sided of the work piece, both rollers rotating at the

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<sup>1</sup> United States Patent No. 4,651,757 to Ohyatsu et al teaches that tobacco to be recycled is preferably handled without excessive crushing or damage of the tobacco product (col. 6 lines 10-15).

same peripheral speed, slower than the peripheral speed of the tension rollers (col. 4 lines 41-65; col. 1 lines 19-25 and col. 3 lines 26-29 and 51-55).

Regarding Claim 8: Wright further discloses the rollers operating on substantially parallel axes (figure 1 and figure 6 showing elements 49-52).

Regarding Claim 9: Wright further discloses:

the axes of rotation of the tension rollers occupy a common plane disposed transversely to the longitudinal axis of the diverted continuous rod;  
the axes of rotation of the brake rollers occupy a common plane disposed transversely to the longitudinal axis of the diverted continuous rod (figure 1 and figure 6 showing elements 49-52).

Regarding Claim 10: Wright additionally discloses a transmission means coupled to a drive component that sets the brake rollers and tension rollers in motion (col. 4 lines 41-65).

Regarding Claim 11: Wright additionally discloses a transmission component between a braking roller and a drive component (col. 4 lines 41-65).

Various transmission means obvious: It was known at the time of invention that belt drives and gearing systems are substitutes for each other (United States Patent No. 3,567,010 col. 4 lines 29-31). It is notoriously well known in the art of gearing and transmissions that multiple gearing arrangements can be used to accomplish substantially identical results.

Regarding Claim 10-19: Wright discloses a system of braking rollers and tension rollers that operate with the same function as that described in the application. Claims 10-19 recite limitations relating to the arrangement of transmission means particularly relating to the arrangement of belts and gears. It would be obvious to one having ordinary skill

in the art of transmission devices to substitute the transmission means disclosed in claims 10-19 for that disclosed in Wright because such variations are well known substitutes (see "Various transmission means obvious" above). Additionally, Wright discloses that the brake rollers are geared to turn at the same peripheral speed, the tension rollers are geared to turn at the same peripheral speed (col. 4 lines 41-65), and the axes upon which the brake rollers turn lie in the same plane (see figure 1 and figure 6 elements 49-52).

Regarding Claim 20: Wright additionally discloses that the separating action of the device is generated without the use of cutting elements (col. 1 lines 19-25 and col. 3 lines 26-29 and 51-55).

Regarding Claim 21: Piana discloses a forming unit that generates a continuous rod (cigarette making machine in abstract), a cutter device (abstract) for cutting into discrete portions, and a cut-off device (figure 1 element 1) between the two. The cutoff of Pianna is capable of being in a disengaged position and an engaged position wherein the continuous rod is cut through and diverted from the feed path (abstract). The separation device "as in preceding claims"<sup>2</sup> is disclosed as described in the treatment of claim 1. Therefore it would have been obvious to combine Wright with Piana to obtain the invention as specified in Claims 1-3 and 7-21.

Regarding Claim 22: Pianna discloses a method for separating at least one continuous rod of forming material into a plurality of reclaimable lengths (abstract). As described in

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<sup>2</sup> For the purposes of compact examination "as in preceding claims" is interpreted as incorporating the limitations of claim 1.

the treatment of claim 1 the rod is separated by forces oriented parallel to the longitudinal axis of the rod from opposing directions.

Regarding Claim 23: The method as disclosed in Wright would apply sufficient force to cause the rod to break by tearing under tensile stress (col. 1 lines 19-26 and col. 3 lines 26-29 and 51-55).

Regarding Claim 24: The separating in Wright is effected without cutting operations (col. 1 lines 19-26 and col. 3 lines 26-29 and 51-55).

***Allowable Subject Matter***

(3)

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: A search of the prior art did not show “an irregular profile, in such a manner as to engage the diverted continuous rod intermittently at predetermined intervals” in combination with the other limitations of claim 4.

***Conclusion***

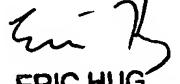
**(4)**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Edel whose telephone number is (571) 272-4804. The examiner can normally be reached on 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBE

  
ERIC HUG  
PRIMARY EXAMINER